

REMARKS

The Examiner, in the Official Action dated October 9, 2003, has noted the allowability of claim 15 which Applicants respectfully acknowledge.

The Examiner, in the Official Action, has also maintained a rejection of the remaining claims for substantially the same reasons set forth in the previous official action. In response to Applicants previous arguments, the Examiner states "If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art". The Examiner has cited MPEP 2113 in support of the position as taken with respect to the claims. In this regard, Applicants respectfully submit that the independent claims include structural features not taught or suggested by the prior art. First, Applicants would like to state that functional limitations are appropriate and must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. See MPEP 2173.05(g).

In particular, Applicants refer the Examiner to independent claim 1 which includes, 1) an order form for ordering of goods and/or services, and 2) an instruction form for associating the plurality hardcopy prints. Thus, it can be seen that there are two separate order forms in the present invention, one for ordering goods and services, and a separate distinct form for association with particular hardcopy prints. The instruction form includes a code that is machine readable. The code is a structural feature of the instruction form and therefore must be taken as a limitation. Furthermore, the code provides information used in organizing the digital images into groups or categories. These are the digital images provided on hardcopy prints and the digital images are obtained by the hardcopy prints. Thus, it can be seen there are very specific structural features provided and that the features have functional limitations that are required to be performed. The code must be capable of being machine read and also must be capable of providing information for use in organizing digital images into groups or

categories. The prior art totally fails to teach or suggest the invention as set forth by Applicants in independent claim 1. The primary Nelson reference relied upon by the Examiner is simply directed to an order form for ordering particular products. Thus, there is only a single form and there is no teaching or suggestion providing a separate instruction form as claimed by Applicants. The instruction form of the present invention is a positive structural recitation. Since the Nelson reference does not teach or suggest an instructional form, it could not teach the machine readable code as also taught and claimed by Applicants. Accordingly, the Nelson reference by itself could not render Applicants invention obvious.

The Examiner has also cited the Hicks reference in combination with the Nelson reference. The Hicks reference is simply directed to an order form for ordering prints in which a customer may select from a group of packages the appropriate indication on the order form. There is no teaching or suggestion of providing an instruction form in combination with an order form as taught and claimed by Applicants. Thus, they could not teach or suggest the invention by itself. Furthermore, there is no teaching or suggestion or motivation for combining Hicks and Nelson. The combining of references must be based on an objective evidence of record. There is no teaching or suggestion as to why one of ordinary skill in the art could combine Hicks with Nelson and even if they did, there is no teaching or suggestion of how the claim limitations of the present invention could be arrived at.


The Examiner has also cited the Johnson reference in combination with the Hicks and Nelson patents for teaching of the present invention. In particular, the Johnson reference is directed to a form having fields which can be selected. The Johnson and Wentworth references are also believed to be of little relevance to the present invention as currently set forth. The Johnson reference is simply directed to reading forms and interpreting the information thereon. There is no teaching or suggestion providing both an order form and an instruction form for use in organizing images that are provided in hardcopy prints as taught and claimed by Applicants. Likewise, Wentworth is nothing more than a filing system for filing household documents. As can be seen, the four references are all directed to totally apart and distinct references and there is no teaching or suggestion as to why any of them should be combined together, or for that fact how the claim limitations could be arrived at. There is no objective evidence in

any of the references for making the suggested combination or to the modifications to arrive at Applicants invention.

Applicants have also submitted new claims 51 and 52 which are directed to a method of organizing images. The prior art references clearly do not teach or suggest the method of organizing images as set forth therein. All of the cited references are directed to specific type forms and/or ordering of goods or services. There is no teaching or suggestion of organizing images as taught and claimed by Applicants.

In view of the foregoing, Applicants respectfully subject that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,


Attorney for Applicant(s)
Registration No. 27,370

Frank Pincelli/phw
Rochester, NY 14650
Telephone: 585-588-2768
Facsimile: 585-477-4646